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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,735	11/13/2003	Indran Naick	AUS920030775US1(4017)	2703

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EXAMINER

NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
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2143

MAIL DATE	DELIVERY MODE
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08/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,735

Applicant(s)

NAICK ET AL.

Examiner

Phuoc H. Nguyen

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to Amendment filed June 6, 2007.
2. Claims 1-20 are pending in this application. Claims 1, 9, and 17 are independent claims.

This Office Action is made final.

Claim Objections

3. Claims 1, 9, and 17 are objected to because of the following informalities:

Re claim 1, the applicant is advised to rewrite the phrase "the call is to the code" as "the call to the code" for clarification.

Re claims 9 and 17, they have the same objection as seen in claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-13, 15-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Erev et al. (U.S. Publication No. 2003/0084106).

Re claim 1, Erev discloses in Figures 2-5 a method for replacing an email attachment associated with an email with a call to code (e.g. abstract and Figure 2 wherein the call is the reference to the location of the attachment which stored in the media store server and further the call to code is the reference to the location as URI seen in paragraph [0005]), the method comprising:

removing the email attachment from the email, and producing a stripped email (e.g. RS2 in Figure 2 which remove the attachment from the email message generated from the attachment box);

storing the email attachment (e.g. storing the attachment as multi-media data in the media 2 in Figure 2);

adding the call to the stripped email (e.g. generate a reference as call and attach to the email prior sending to the RC 1 in Figure 2),

generating the call (e.g. paragraphs [0014-0020] wherein the reference to the location is dynamically generated corresponding to the location of storing the attachment), wherein the call is to the code that downloads the email attachment upon activation of the call by a recipient of the strip email (e.g. paragraphs [0009] and [0019]); and

forwarding the stripped email with the call to the recipient upon activation of the call (e.g. from RS2 to RC1 in Figure 2).

Re claim 2, Erev further discloses in Figures 2-5 receiving a request for transmission of the email attachment in response to activation of the call (e.g. paragraph [0019] wherein the request is made from the media client to the media store); and

transmitting the email attachment to the recipient in response to the request (e.g. the media store send the attachment file as multi-media data corresponding to the reference to the media client).

Re claim 4, Erev further discloses in Figures 2-5 partitioning a mail server to create the attachment server (e.g. paragraph [0089] wherein the mail server and media server are located in the same machine).

Re claim 5, Erev further discloses in Figures 2-5 storing comprises storing the email attachment in storage associated with an attachment server (e.g. file is stored from SC1 to media store in Figure 2), the attachment server being configured to transmit the email attachment in response to activation of the call by the recipient (e.g. paragraph [0035]).

Re claim 6, Erev further discloses in Figures 2-5 adding the call comprises adding code to the email, the code being configured to automatically execute upon display of the email via an email client associated with the recipient, to request transmission of the email attachment (e.g. paragraphs [0032-0035] wherein the code is the reference in form of URI).

Re claim 7, Erev further discloses in Figures 2-5 adding the call comprises adding a hyperlink to the stripped email, wherein the hyperlink is configured to initiate code associated with the email attachment to transmit the email attachment to the recipient (e.g. paragraphs [0005 and 0032-0035]).

Re claim 8, Erev further discloses in Figures 2-5 the hyperlink, upon activation, initiates access to an Internet protocol address associated with the code for the retrieval of

the email attachment (e.g. paragraphs [0032-0035] wherein the code is the reference in form of URI).

Re claim 9, it is a device claim of claim 1. Thus, claim 9 is also rejected under the same rationale as cited in the rejection of rejected claim 1.

Re claim 10, it is a device claim of claim 2. Thus, claim 10 is also rejected under the same rationale as cited in the rejection of rejected claim 2.

Re claim 11, it is a device claim of claim 3. Thus, claim 11 is also rejected under the same rationale as cited in the rejection of rejected claim 3.

Re claim 12, it is a device claim of claim 4. Thus, claim 12 is also rejected under the same rationale as cited in the rejection of rejected claim 4.

Re claim 13, it is a device claim of claim 5. Thus, claim 13 is also rejected under the same rationale as cited in the rejection of rejected claim 5.

Re claim 15, it is a device claim of claim 7. Thus, claim 15 is also rejected under the same rationale as cited in the rejection of rejected claim 7.

Re claim 16, it is a device claim of claim 6. Thus, claim 16 is also rejected under the same rationale as cited in the rejection of rejected claim 6.

Re claim 17, it is a computer-accessible medium claim of claim 1. Thus, claim 17 is also rejected under the same rationale as cited in the rejection of rejected claim 1.

Re claim 18, it is a computer-accessible medium claim of claim 2. Thus, claim 18 is also rejected under the same rationale as cited in the rejection of rejected claim 2.

Re claim 20, it is a computer-accessible medium claim of claim 4. Thus, claim 20 is also rejected under the same rationale as cited in the rejection of rejected claim 5.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erev et al. (U.S. Publication No. 2003/0084106) in view of Hanna et al. (U.S. 7,054,905).

Re claim 3, Erev fails to disclose in Figures 2-5 authenticating the request prior to transmission of the email attachment. However, Hanna et al. disclose the step of authenticating the request prior to transmission of the email attachment (e.g. 314 in Figure 3 as authentication is required prior downloading attachment from server). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention is made to add the step of authenticating the request prior to transmission of the email attachment as seen in Hanna et al.'s invention into Erev et al.'s invention because it would enable to allow only authorized user to view the attachment for security reason (e.g. col. 5 lines 7-16).

Re claim 14, it has similar limitations cited in claim 3. Thus, claim 14 is also rejected under the same rationale as cited in the rejection of rejected claim 3.

Re claim 19, it is a storage type accessible medium claim of claim 3. Thus, claim 19 is also rejected under the same rationale as cited in the rejection of rejected claim 3.

Response to Arguments

8. Applicant's arguments filed June 6, 2007 have been fully considered but they are not persuasive.

The applicant argues in page 9 third paragraph for claim all independent claims that the cited reference by Erev fails to disclose the limitation "the call is to code" wherein the email attachment is called by a piece of generated code wherein the call may be represented by a hyperlink to the generated code to forward the email.

The examiner respectfully submits that the argued limitations above are either clearly, inherently, or expressively seen in the primary reference wherein the call to the code is the inserted reference dynamically generated upon the activation path as seen in Figure 2. This reference is represented by the hyperlink (e.g. paragraph [0005]) to a dynamic and specific location of the attachment email. Further, this inserted reference is not only the pointer to the location but it also can be executed to stream the attachment upon the activation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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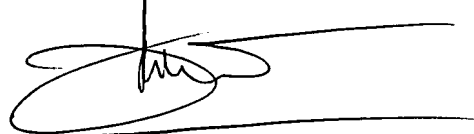
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Phuoc H Nguyen
Examiner
Art Unit 2143

A handwritten signature in black ink, appearing to be 'Phuoc H. Nguyen', written over a horizontal line.

August 19, 2007